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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,372	12/20/2001	Peter Antonio Navarro Y Koren	BO 44907	3493
466	7590	05/13/2004	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			PADEN, CAROLYN A	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/022,372

Applicant(s)

NAVARRO Y KOREN ET AL.

Examiner

Carolyn A Paden

Art Unit

1761

-- The MAILING DATE of this c mmunication appears on the cover sheet with th correspondence address --
Peri d f r R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8-20-03
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-20-03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The solubility of the calcium used in part b is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a degree of methoxylation of less than 50 or between 5 and 45, as disclosed at page 9, lines 19-25, does not reasonably provide enablement for a degree of methoxylation between 2 and 50. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the fermentation of oligosaccharide by intestinal bacteria that is capable of increasing the total cecal SCFA, does not reasonably provide enablement for the oligosaccharide being capable of increasing the total cecal SCFA. The specification does not enable any person skilled in the art to which it pertains, or with which it is

most nearly connected, to practice the invention commensurate in scope with these claims.

Claim 3 is objected to because of the following informalities:

Claim 3 contains the abbreviation SCFA. If applicant intends to indicate –short chain fatty acids (SCFA)-, then an amendment to the claims clarifying this issue would overcome the objection.

Appropriate correction is required.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition containing pectin, does not reasonably provide enablement for a method for the treatment or prevention of overweight or obesity in mammals utilizing enteral administration of the liquid. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention. There are no specific examples in the specification that show that the composition of the claims is effective in the treatment or prevention of overweight or obesity in mammals. The general description that includes the preamble of claim 14 is not sufficient disclosure to set forth what is considered to be an effective amount of the composition because no weight loss has been described or shown. Further at page 6, line 17; the weight loss is described as an "aim". It is not seen that a description of an "aim" is an effective treatment for obesity.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagata et al. (6,187,334)

Yamagata discloses an edible composition that is suitable for injection that includes low-methoxylpectin, sodium alginate, alginic acid and other thickening agents as well as calcium. The composition is packed into aluminum pouches for heat processing and preservation. At example 8


sodium alginate and low methoxyl pectin are combined together with calcium gluconate to provide a composition that was antiemetic with a pH of 7. At Table 1, at the bottom of columns 7 and 8, the viscosity of the composition is shown for various levels of pectin. Claim 1 appears to differ from the reference in the suggestion of the inclusion of an amount of oligosaccharide in the composition. But it would have been obvious to include oligosaccharide in the composition of Yamagata in order to fortify the composition with a nutritive carbohydrate. It is appreciated that protein is not included in Yamagata but protein would also have been an obvious way to enhance the nutritional content of the Yamagata composition. It is also appreciated that the solubility of calcium is not included in Yamagata. But no unobvious or unexpected results are seen from the selection of a calcium source, particularly when Yamagata provides for the same calcium sources as applicant at column 4, lines 1-10.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone

number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398 or by dialing 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CAROLYN PADEN 5-10-04
PRIMARY EXAMINER 1761